

REMARKS

Applicant has reviewed and considered the Office Action mailed on January 5, 2004, and the references cited therewith.

None of the claims are amended or canceled. Claims 1-29 are pending in this application.

§103 Rejection of the Claims

Claims 1-4, 6-9, 11-14, 18-20, 22, 24, 25, 28 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Helland et al. (U.S. Patent No. 5,545,201) in view of Barcel (U.S. Patent No. 5,275,171) and further in view of Cobain et al. (U.S. Patent No. 5,796,044).

Applicant traverses the rejections. The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The Fine court stated that:

Obviousness is tested by “what the combined teaching of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And “teachings of references can be combined only if there is some suggestion or incentive to do so.” *Id.*

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness since there is no suggestion or motivation to combine the cited references and the references teach away from applicant's claimed invention.

Applicant notes that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. Here, the Office Action asserts on page 4 that "[i]t would have been obvious ... to have used a second conductor having an outer surface surrounded by an insulative coating in the Helland et al. system in order to insulate the second conductor from the impact of body fluids encountered during lead insertion, hence preventing metal migration and the breakdown of the lead insulation." However, this is a hindsight solution to a non-existent problem being asserted as a motivation for modifying the Helland et al. reference. Helland et al. discuss that the lead of Figure 6 includes a plug 176 and an o-ring 188 to seal and prevent fluid invasion into the lead body 122. Accordingly, there is no motivation to modify Helland in view of the Cobian reference, as suggested by the Office Action.

Moreover, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). As discussed, Helland et al. discuss that the lead of Figure 6 includes a plug 176 and an o-ring 188 to seal and prevent fluid invasion into the lead body 122. Accordingly, no further need for insulation is suggested by the reference itself, and Helland et al. teach away from such subject

matter. Reconsideration and allowance of claims 1-4, 6-9, 11-14, 18-20, 22, 24, 25, 28 and 29 is respectfully requested.

Claims 5, 21, 23, 26 and 27 were rejected under 35 USC § 103(a) as being unpatentable over Helland et al. (U.S. Patent No. 5,545,201) in view of Barcel (U.S. Patent No. 5,275,171) and further in view of Cobain et al. (U.S. Patent No. 5,796,044) and further in view of Altman et al. (U.S. Patent No. 5,845,396).

Claims 5, 21, 23, 26, and 27 depend, directly or indirectly, on claims 1, 18, and 24, respectively, and are patentable over the cited references for the reasons argued above. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03. Moreover, Applicant traverses the rejections of claims 5 and 21 and 26 since the Office Action has not provided sufficient motivation to modify the reference. The Office Action states on pages 4 and 5 that Altman et al. teach signal conduction using a lead with polyimide or polyurethane coated conductors “for the purpose of isolating the conductors so noise and artifacts do not degrade the quality of the electrical signals.” However, Applicant cannot find such subject matter in the Altman reference. Accordingly, the Office Action has not provided sufficient evidence of motivation to support a rejection under 35 U.S.C. 103.

Regarding claims 23 and 27, the Office Action asserts that it would be obvious to modify the Helland system by using the heat shrunk PTFE/ETFE insulation discussed by Altman. However, Altman et al. discuss a technique to manufacture a co-radial coiled lead without having the coils unwind during manufacture. (Abstract, Altman et al.). In contrast, Helland discusses non-co-radial leads and there is no suggestion of the subject matter of Altman being applicable to the lead of Helland. Moreover, this subject matter also leads away from parent claims 1, 18, and 24, which recite non co-radial first and second conductors.

Moreover, regarding claims 5, 21, 23, 26, and 27, Applicant traverses the obvious-design-choice rationale of the Examiner. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v.*

Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. Here, the Examiner has focused on the differences between the claims and the cited references and has not provided a sufficient motivation for making the alleged combinations. Reconsideration and allowance is respectfully requested.

Claims 10, 15-17 and 22 were rejected under 35 USC § 103(a) as being unpatentable over Helland et al. (U.S. Patent No. 5,545,201) in view of Barcel (U.S. Patent No. 5,275,171) and further in view of Cobain et al. (U.S. Patent No. 5,796,044) and further in view of Doan (U.S. Patent No. 5,425,755).

Claims 10, 15-17, and 22 depend, directly or indirectly, on claims 1, 11, and 18, respectively, and are not obvious over the cited references for the reasons argued above. Moreover, Applicant traverses the rejection of claims 10, 15-17, since Doan discusses a technique to manufacture a co-radial coiled lead. In contrast, Helland discusses non-co-radial leads and there is no suggestion of a need for the subject matter of Doan being applicable to the lead of Helland. Moreover, this subject matter also leads away from parent claims 1 and 18, which recite non co-radial first and second conductors.

Regarding claim 22, Applicant traverses the rejection since, even if combined, the combination would not include “disposing polyurethane tubing between the first conductor and the second conductor.” The Office Action directs attention to Doan for this subject matter, but Applicant can only find in Doan discussion of a polyurethane outer tubing. (Col. 2, lines 17-26). Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743


Respectfully submitted,

JEFFREY P. BODNER

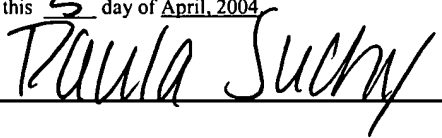
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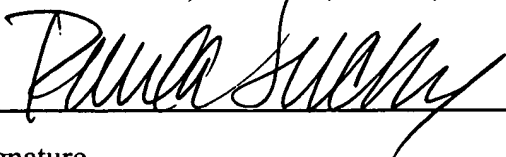
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